

REMARKS

1. Rejections

Claims 1-19 stand rejected under 35 U.S.C. § 102(b), as allegedly anticipated by U.S. Patent No. 6,138,119 to Hall *et al.* (“Hall”). Applicant respectfully disagrees.

2. 35 U.S.C. § 102(b)

Claims 1-19 stand rejected as allegedly anticipated by Hall. “A claim is anticipated if and only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP 2131. The Office Action alleges that Hall describes each and every element as set forth in claims 1-19. Applicant respectfully disagrees.

Specifically, Applicant’s claim 1 describes a method for managing information over a networked system of computers comprising the steps of “gathering compliance data . . .; supplementing and formatting a portion of said compliance data to create modified compliance data.” (Emphasis added.) Similarly, claim 13 describes a computer system for managing compliance data comprising “means for supplementing and formatting said compliance data creating modified compliance data.” (Emphasis added.) For example, in an embodiment of the invention, the compliance data is supplemented, *i.e.*, the content of the compliance data is modified, and the supplemented compliance data is formatted resulting in modified compliance data. For example, a portion of the gathered compliance data may be removed, and the remaining portion of the compliance data may be formatted to generate the modified compliance data. The modified compliance data then may be classified or organized into one of thirteen categories.

In contrast, Hall describes a descriptive data structure 200 (“DDS”) which is associated with a rights management data structure, *e.g.*, a newspaper 102 or a magazine 106. DDS 200 includes DDS definitions 202. For example, when the rights management data structure is newspaper 102, DDS definitions 202 define a generic format that a newspaper style publication could use. Specifically, a first DDS definition 202a does not specify a particular headline of newspaper 102, *e.g.*, Yankees Win the Pennant, but instead defines a location of the headline within newspaper 102. Because DDS 200 is generic to a class or a family of style content publications, it can be reused. See, e.g., Hall, Column 10, Lines 58-68; and Column 11, Lines 1-3. In another example, when rights management data structure is magazine 106, because

magazines typically do not include headlines or breaking news, DDS 200 may not define such formatting. Instead, DDS 200 for magazine 106 may define issue date, a magazine title, the name of the photographer, and associated artwork designation.

The Office Action appears to acknowledge that Hall's rights management data is not "supplemented," as described in Applicant's claims 1 and 13. Specifically, the Office Action states that "Hall's data is formatted and has the capacity to be modified and supplemented in a manner described in Applicant's claim language above." Office Action, Page 4, Lines 2-4. Because the Office Action merely asserts that Hall's data "has the capacity" to be modified and supplemented, Applicant understands that the Office Action does not allege that Hall actually discloses or suggests modifying or supplementing such data. Nevertheless, as noted above, "[a] claim is anticipated if and only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131 (emphasis added.) Because Hall does not disclose or suggest modifying the data, Applicant maintains that the Office Action fails to satisfy its burden of establishing that Hall anticipates claims 1 and 13. Therefore Applicant respectfully requests that the Examiner withdraw the anticipation rejection of claims 1 and 13. Claims 2-12 and 14-19 depend from claims 1 and 13, respectively. Therefore, Applicant respectfully requests that the Examiner also withdraw the anticipation rejection of claims 2-12 and 14-19.

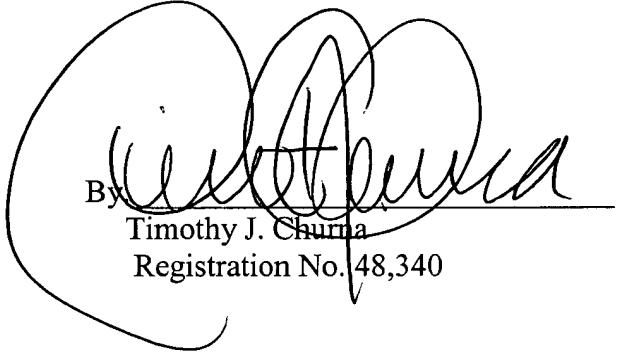
Moreover, Applicant notes that although the Office Action does not raise any obviousness-type rejections in the above-captioned patent application, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP 2143.01 (emphasis added.) Similarly, "[a]lthough a prior art device may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation [provided] in the reference to do so." *Id.* (emphasis added.) Therefore, even if Hall's data can be or is capable of being modified or supplemented as required by Applicant's claimed invention, such a capability is not even sufficient to render Applicants' claimed invention obvious. (Emphasis added.) Instead, the Office Action also must show that Hall or another reference "suggests the desirability" of the modification. (Emphasis added.)

CONCLUSION

Applicant respectfully submits that this application is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that an interview with Applicant's representatives, either in person or by telephone, would expedite prosecution of this application, we would welcome such an opportunity. Applicant believes that no fees are due as a result of this response. Nevertheless, in the event of any variance between the fees determined by Applicant and those determined by the U.S. Patent and Trademark Office, please charge any such variance to the undersigned's Deposit Account No. 02-0375.

Respectfully submitted,

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